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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/661,310	09/12/2003	Jon C. Marine	MAT 3D9A	7828
23581	7590	02/24/2004		
KOLISCH HARTWELL, P.C. 520 S.W. YAMHILL STREET SUITE 200 PORTLAND, OR 97204			EXAMINER ABDELWAHED, ALI F	
			ART UNIT 3712	PAPER NUMBER

DATE MAILED: 02/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/661,310	MARINE ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ali Abdelwahed	3712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Claim Objections***

Claims 16, 20, 25, 31, and 33 are objected to because of the following informalities:

It is suggested that in:

Claim 16, delete one of the periods ending the claim.

Claim 20, line 2, before "...remaining..." delete "the" and insert --a--.

Claim 20, line 2, after "...remaining..." insert --portion of--.

Claim 25, line 2, delete "engages" and insert --engage--.

Claim 31, line 4, delete "drive" to avoid any lack of antecedent basis errors.

Claim 33, line 2, delete "drive" and insert --driven-- to agree with the limitations in the base claim.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 16-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 16 recites the limitation "the independent parts" in line 3. There is insufficient antecedent basis for this limitation in the claim.

Claims 17, 18, and 22-33 recite the limitation "the children's toy" in line 1. There is insufficient antecedent basis for this limitation in the claims.

Claim 19 recites the limitations "the cam recess region", "the cam lobe portion", and "the cam recess" in lines 1-2. There is insufficient antecedent basis for these limitations in the claim.

Claim 20 recites the limitation "the cam recess region" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 21 recites the limitations "the drive cam-bearing surface", "the size", "the contact area", and "the bearing surface region" in lines 1-3. There is insufficient antecedent basis for these limitations in the claim.

Claim 23 recites the limitations "the cam lobe portion", and "the remaining driven teeth" in lines 1 and 3. There is insufficient antecedent basis for these limitations in the claim.

Claim 25 recites the limitations "the cam lobe portion", and "the non-rotating configuration" in lines 1-3. There is insufficient antecedent basis for these limitations in the claim.

Claim 31 recites the limitations "the perimeter", and "the opposite direction" in lines 2 and 4. There is insufficient antecedent basis for these limitations in the claim.

Claim 33 recites the limitation "the group" in line 2. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

Claims 14, 15, and 34 are rejected under 35 U.S.C. 102(a) as being anticipated by PCT- WO 01/49383 A1 to Chung.

Chung discloses twin inter-engaged, motion coupled, substantially parallel axis rotors (58, 62) operatively mounted for juxtaposed relative intermittent rotation (see pgs. 5, 6), each rotor including: a toothed region (65A) which lies along an arc that is less than a full circle (see figs. 3A, 3B); and a cam region (65B) including a portion of which lies substantially outside that arc toothed region (see figs. 3A, 3B), the rotors being

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operatively positioned relative to one another in a manner which enables two different characters of inter-engaged relative rotating motion, one of the characters involving tooth-region to tooth-region driving inter-engagement, wherein the two rotors counter rotate relative to one another, with one rotor driving the other rotor, and the other character involving sliding surface to sliding surface, non-driving inter-engagement, wherein the one rotor rotates and the other rotor is stationary (see figs. 3A, 3B, and respective portions of the specification), the first character of inter-engaged relative rotation motion occurring at a predefined sweep of angular relation between the twin rotors and the second character of inter-engaged relative rotation motion occurring at two predefined angular relations between the twin rotors positioned on either side of the sweep that defines the first character of inter-engaged relative rotation (see figs. 2A-3C, and respective portions of the specification); the toothed regions include portions extending across a common plane which is spaced from and generally normal to the axes (see figs. 3A, 3B). Regarding claim 34, a drive gear (56) having a set of drive teeth (see fig. 3B) and a means to selectively engage a set of driven teeth on a corresponding driven gear (see figs. 3A, 3B); a driven gear (58) having a set of driven teeth (65A) a means to align the set of driven teeth with the set of drive teeth of the drive gear (see figs. 3A, 3B); and at least two rotation locking means (65B and camming regions of gears 56, 57) for preventing the driven gear from rotating in response to a rotation of the drive gear (see figs. 3A, 3B, and corresponding portions of the specification).

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-13 and 16-33 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-36 of U.S. Patent No. 6,623,327 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter of the present application is fully disclosed in the specification of U.S. Patent No. 6,623,327 B2 and is covered by the claims of U.S. Patent No. 6,623,327 B2. The claims of U.S. Patent No. 6,623,327 B2 are inclusive for they are drafted using the "comprising-type" format and cover the claimed subject matter of the present application.

Claims 14, 15 and 34 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-37 of U.S. Patent No. 6,547,632 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed subject matter of the present

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application is fully disclosed in the specification of U.S. Patent No. 6,547,632 B2 and is covered by the claims of U.S. Patent No. 6,547,632 B2. The claims of U.S. Patent No. 6,547,632 B2 are inclusive for they are drafted using the "comprising-type" format and cover the claimed subject matter of the present application.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ali Abdelwahed whose telephone number is (703) 305-3311. The examiner can normally be reached Monday through Friday from 9:00 A.M. to 5:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

AA  
02/19/2004



**DERRIS H. BANKS**  
**SUPERVISORY PATENT EXAMINER**  
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